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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 1033-A00498-C1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 4-2-07

Signature [signature]

Typed or printed name: Jeaneaux Jordan

Application Number	Filed
10/621,127	July 16, 2003

First Named Inventor: Theodore James Myers, et al.

Art Unit	Examiner
2617	DOAN, Phuoc Huu

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 38,342
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

[signature]
Signature

Jeffrey G. Toler
Typed or printed name

512-327-5515
Telephone number

4-2-2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [x] *Total of 1 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Theodore James Myers, et al.		
Title:	OVER THE AIR USER ZONE ASSIGNMENT FOR WIRELESS TELEPHONY SYSTEMS		
App. No.:	10/621,127	Filed:	July 16, 2003
Examiner:	DOAN, Phuoc Huu	Group Art Unit:	2617
Customer No.:	60533	Confirmation No.:	1949
Atty. Dkt. No.:	1033-A00498-C1		

MS: AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REMARKS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

In response to the Final Office Action mailed January 11, 2007 ("Final Action"), and further pursuant to the Notice of Appeal and Pre-Appeal Brief Request for Review submitted herewith, Applicants respectfully request review and reconsideration of the Final Action in view of the following issues.

Claims 18-30 are Allowable

The Office has rejected claims 18-30, at paragraphs 2 and 3 of the Final Action, under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. App. Pub. No. 2003/0182052 ("DeLorme") in view of U.S. Patent No. 5,903,832 ("Seppanen"). Applicants respectfully traverse the rejections.

None of the cited references, including DeLorme and Seppanen, disclose or suggest the specific combination of claim 18. For example, as acknowledged by the Final Action, DeLorme does not disclose or suggest receiving user inputs to define a user zone, where the user zone comprises a desired area of operation to subscribe to wireless service options, as recited in claim

18. (*See* Final Action, p. 4). Further, Seppanen does not disclose or suggest receiving user inputs to define a user zone, where the user zone comprises a desired area of operation to subscribe to wireless service options, as recited in claim 18. In contrast to claim 18, Seppanen discloses a user selecting a cellular telephone network from a list of available networks based either on the name of the network or based on the services (e.g. data, short message service) offered by the network. (*See* Seppanen, col. 7, ll. 54-64 and col. 8, ll. 54-65). Seppanen does not disclose or suggest receiving user inputs to define a desired area of operation to subscribe to wireless service options, as recited in claim 18. Rather, Seppanen discloses an area of operation defined only by the capability of a mobile station to place a call via a particular network. Hence, claim 18 is allowable.

Claims 19-30 depend from claim 18, which Applicants have shown to be allowable. Hence, DeLorme and Seppanen fail to disclose at least one element of each of claims 19-30. Accordingly, claims 19-30 are also allowable, at least by virtue of their dependency from claim 18.

Further, there is no suggestion or motivation to make the asserted combination of references in the nature of the problem to be solved, the teachings of the prior art, or the knowledge of persons of ordinary skill in the art. "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor." *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998). The Final Action has selectively culled portions of DeLorme and combined them with portions of Seppanen. DeLorme is directed to a mapping and routing system that allows a user to designate a travel route where information related to the travel route may be accessed and stored at a PDA. (*See* DeLorme, Abstract). Seppanen is directed to allowing a user to specify priorities used to automatically select an available network or allowing a user to manually select an available network based on the network name or services provided by the network. (*See* Seppanen, col. 3, lines 40-50). Since DeLorme and Seppanen are not analogous and address different and unrelated problems, the references themselves must include

some motivation or teaching to make the asserted combination. However, neither DeLorme, nor Seppanen, disclose or suggest any motivation to combine the PDA accessible mapping and routing system of DeLorme with the cellular network selection menus of Seppanen. Therefore, the only motivation to look to the particular references, to select the particular elements cited in the Final Action, and to combine them in the manner stated in the Final Action comes from Applicants' disclosure. This constitutes an impermissible hindsight rejection based on Applicants' disclosure. Hence, the rejection of claims 18-30 over the combination of DeLorme and Seppanen is improper and should be withdrawn.

Claims 31-33 and 36-40 are Allowable

The Office has rejected claims 31-33 and 36-40, at paragraph 4 of the Final Action, under 35 U.S.C. § 103(a) as being unpatentable over DeLorme in view of U.S. Pat. App. Pub. No. 2006/0116507 ("Oppermann"). Applicants respectfully traverse the rejections. In particular, Applicants submit that this rejection is improper, apparently as a result of a computer error within the Patent and Trademark Office.

If a search for U.S. Pat. App. Pub. No. 2006/0116507 is conducted using the Patent Application Full Text and Image Database (the "Patent Database"), a patent application entitled "Osteogenic Devices" by applicants Hermann Oppermann et al. (the "Oppermann application") is presented as the sole search result. The Oppermann application purports to have the publication number 2006/0116507. The application serial number of the Oppermann application is 08/957,425, and its filing date is October 24, 1997.

A search conducted in the Patent Application Information Retrieval (PAIR) system relating to Patent Application Serial No. 08/957,425 shows that this application was published on April 10, 2003, as Pat. App. Pub. No. 2003/0069401, and issued on July 1, 2003, as Patent No. 6,586,388 (the "'388 patent"). The '388 patent is directed to osteogenic devices, to DNA sequences encoding proteins which can induce new bone formation in mammals, to methods for the production of these proteins in mammalian cells using recombinant DNA techniques, to antibodies capable of binding specifically to these proteins, to bone and cartilage repair procedures using the osteogenic devices, and to matrix materials useful for allogenic or xenogenic implants and which act as a carrier of the osteogenic protein to induce new bone

formation in mammals. (*See* '388 patent, col. 1, ll. 47-59). The '388 patent does not disclose or suggest determining a location of a mobile terminal of a user by receiving GPS data at said mobile terminal, as recited in claim 31. The '388 patent also does not disclose or suggest a graphical user interface to display location information and to receive user inputs to select a desired user zone of service, as recited in claim 38.

Further, if a search for Publication No. 2006/0116507 is conducted in the PAIR system, the sole search result is a patent application entitled "Method and System for Provisioning a Wireless Device" to Yue Chen et al. (the "Chen application"), filed November 30, 2004. The documents accessible via the "Transmittal of New Application" and "Specification" icons under the "Image File Wrapper" tab of the PAIR system for the Chen application indicate a filing date of November 30, 2004, and that the specification, claims, and drawings for the Chen application are the same as those of Publication No. 2006/0116507. It appears that a computer error in the Patent Database has incorrectly associated the title, application number, filing data, and related U.S. application data of the '388 patent with the Chen application. Thus, the Chen application appears to be the source of the disclosure cited in the Final Action. However, since the Chen application was not filed until November 30, 2004, it is not prior art to the present application. Though Applicants have raised this issue previously, the Office has maintained its rejection without further explanation.

The rejection of claims 31-33 and 36-40 apparently relies on the Chen application (though calling it Oppermann) to disclose features of independent claims 31 and 38. (*See* Final Action, p. 6-8). Since the Chen application is not prior art to claims 31 and 38, any combination relying on the Chen application cannot be used to reject claims 31 and 38. Therefore, no *prima facie* case of obviousness has been established with regard to claims 31 and 38, and claims 31 and 38 are allowable. Additionally, claims 32-33, 36-37, and 39-40, which depend from claims 31 or 38 are also allowable, at least by virtue of their dependency from claims 31 or 38.

CONCLUSION

In view of the foregoing, Applicants respectfully submit that the pending claims are allowable. Applicants therefore request withdrawal of all pending rejections.

Respectfully submitted,

4-2-2007
Date

Jeffrey G. Toler, Reg. No. 38,342
Attorney for Applicant(s)
TOLER SCHAFFER, L.L.P.
8500 Bluffstone Cove, Suite A201
Austin, Texas 78759
(512) 327-5515 (phone)
(512) 327-5575 (fax)